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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MYHRE, JAMES W

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/995,239	Applicant(s) CHAN ET AL.	
	Examiner JAMES W. MYHRE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 30, 2007 and the after-final amendment filed on November 19, 2007 have been entered.

Response to Amendment

2. This Office Action is in response to the After-Final Amendment filed on November 19, 2007. The Amendment cancelled Claims 11, 13, and 14 and amended Claims 1, 2, 9, and 10. Therefore, the currently pending claims considered below are Claims 1-10 and 15.

Claim Objections

3. The Amendment filed on November 19, 2007 corrected the typographical error in Claim 2 as indicated in paragraph 3 of the August 31, 2007 Final Rejection. Therefore, the Examiner hereby withdraws that objection.

4. Claims 10 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 10 is a computer program product claim that refers back to any of Claims 1 to 9.

Claim 15 is a program product claim that refers back to Claim 1. The Office considers any claim that refers to another claim as dependent thereon, i.e. a dependent claim.

Since Claim 1 is a system claim comprising a memory which stores (software) components for performing the various functions of the system and Claims 10 and 15 fail to add, delete, or change any of these functions or differentiate how the components stored on the memory in the parent claim differs from "A computer program product...comprising a recordable data storage medium" (Claim 10) or "A program product stored on a computer-readable medium", Claims 10 and 15 fails to further limit their parent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

5. The Examiner hereby withdraws the rejection of Claims 1-11 and 13-15 under 35 U.S.C. 112, 1st paragraph as described in paragraphs , 5, 5-1, 6, and 6-1 in the August 31, 2007 Final Rejection.

The Amendment filed on November 19, 2007 corrected the error in Claim 10 as shown in paragraph 8-1 of the August 31, 2007 Final Rejection. Therefore, the Examiner hereby withdraws that rejection.

The Examiner hereby withdraws the rejections of Claims 11, and 13-15 under 35 U.S.C. 112, 2nd paragraph as described in paragraphs 8-2 and 8-3 of the August 31, 2007 Final Rejection.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 15 recites "A program product stored on a computer readable medium". There is no support in the specification for a computer readable medium on which the program product is stored. The closest reference to such a feature in on page 7 recites the "computer program product including computer usable medium" (emphasis added). Since the specification further defines this computer usable medium as including a modulated carrier signal, the program is not stored thereon, only passes through the medium as it is being transmitted.

Claim Rejections - 35 USC § 101

8. The Amendment filed on November 19, 2007 added physical components to the system of Claim 1; thus, overcoming the rejection of Claim 1-9 in paragraph 10-1 of the August 31, 2007 Final Rejection. Therefore the Examiner hereby withdraws that rejection.

However, the rejection of Claim 10 as being directed towards non-statutory subject matter – i.e. an electronic signal per se, still stands. The Applicant has defined the computer program product in the specification as a computer usable medium that includes “computer readable program code means for implementing the system components described above” and that “the computer program can be stored in storage or transmitted as a signal, such as on a modulated carrier signal” page 7). Thus, the computer program product may be an electronic signal per se. The Office considers electronic signals to be a form of energy and thus non-statutory. The Examiner notes that a detailed review of the specification and drawings has not located any disclosure of a physical storage medium that could contain computer readable code that the Applicant could incorporate into these claims to make them statutory.

Claim 15 is also rejected as being directed towards non-statutory subject matter as Claim 10 above. While Claim 15 indicates the program product is “stored on a computer-readable medium” etc., which would place it within statutory subject matter, there is no support in the specification for such a computer-readable medium as described in the 35 U.S.C. 112, 1st paragraph rejection in paragraph 7 above.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4-8, 10/1, 10/4-10/8, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattern et al (6,763,342).

Claim 1: Mattern discloses a computer system for generating user recommendations for a defined knowledge base, the computer system comprising a reasoning model, the reasoning model comprising:

a. a component for storing, maintaining and representing a decision graph definable by an author (The user can modify the decision paths, column 5, lines 44-46), the decision graph comprising nodes and links between the nodes (a tree structure indicating their relationship, column 5, lines 33-54), the nodes comprising a set of decision nodes, and a set of feedback nodes, each of the nodes in the decision graph comprising rules defined by the author to define links to other nodes in the graph based on a processing of user information including probabilistic reasoning (neural networks; column 13, lines 6-9), and for a decision node, to request and obtain user information

(question and reply nodes, column 6, lines 26-35), and for a feedback node, to provide feedback to users (solution nodes, column 6, lines 26-35);

b. a component to traverse the decision graph and fire the rules defined in the decision graph nodes (the reply is evaluated and the knowledge module 208 is accessed to retrieve the next node corresponding to the selected reply, column 12, lines 4-10); and

c. a communication component for communicating the feedback to the users through the webserver to assist the users in making decisions regarding a business transaction (The Web server 202 acts as the presentation layer of the system 200, column 4, lines 56-67).

The Examiner notes that the new limitation that the recommendation providing to the user by the feedback nodes are either an interim or final recommendation is inherent. If the recommendation provided in Mattern is subsequently replaced by another recommendation (i.e. updated), then it was an interim recommendation. If it is not replaced, then it was the final recommendation. Furthermore, Mattern explicitly discloses that the system will present to the user “a series of proposed solutions” (column 4, lines 46-50); thus, it is providing interim recommendations.

Claim 4: Mattern discloses a computer system as in Claim 1 above, and further disclose the nodes contain no information relating to presentation of data to a user (the retrieved information may be assembled with other (page-definition) information stored within the data store 221 to create a Web page, column 11, lines 57-67).

Claim 5: Mattern discloses a computer system as in Claim 1 above, and further disclose the rules defining links to other nodes in the graph comprise rules accessing and evaluating one of:

- a) personalization choices collected implicitly or explicitly from the user (the reply is evaluated; column 12, lines 4-16);
- b) static data relating to the user;
- c) a dynamically generated user model;
- d) attributes of elements in the knowledge base, and;
- e) author-related goals.

Claim 6: Mattern discloses a computer system as in Claim 1 above, and further disclose the decision graph comprises multiple entry points (a leap is used to redirect other decision paths to one common question node, column 6, lines 15-20).

Claim 7: Mattern discloses a computer system as in Claim 1 above, and further disclose the decision graph comprises nodes potentially chaining the decision graph to other decision systems (links to external documents may be added to an answer node, column 10, lines 40-49).

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Claim 8: Mattern discloses a computer system as in Claim 1 above, and further disclose the rules defining links between nodes in the decision graph utilize one of: weighting systems; fuzzy logic systems, and probabilistic reasoning (neural networks, column 13, lines 6-9).

Claims 10/1 and 10/4-10/8: Mattern disclose a computer program product for use in the computer system described in the above claims. Thus, claims 10/1, and 10/4-10/8 are rejected using the same analysis of claims 1 and 4-8 above.

Claim 15: Mattern discloses a program product for use in the computer system described in Claim 1. Thus, Claim 15 is rejected using the same analysis of claim 1 above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, 9, 10/2, 10/3, and 10/9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattern et al (6,763~342) in view of Herz et al (US 2001/0014868)

Claim 2: Mattern discloses a computer system comprising a reasoning model as in claim 1 above and further disclose the decision nodes comprise question nodes (question and reply nodes, column 6, lines 26-35) and the feedback nodes comprise recommendation nodes (solution nodes, column 6, lines 26-35; the solution is presented to the user machine, column 12, lines 38-50), but does not explicitly disclose the feedback nodes comprise promotion nodes. However, Herz discloses a similar computer system for the automatic determination of customized prices and promotions that also automatically constructs product offers tailored to individual shoppers in a way that attempts to maximize the vendor's profits (paragraph 0004). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include promotional nodes in Mattern in order to provide customized prices and promotions which would attempt to maximize the vendor's profits (Herz, paragraph 0004).

Claim 3: Mattern and Herz disclose a computer system as in Claim 2 above, and Herz further disclose promotional nodes comprising cross-sell and up-sell nodes (selects offers from the offer database that are likely to result in profitable sales, paragraph [0037]; present selected offers to shopper, paragraph [0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Mattern to promote cross-sells and up-sells in order to maximize the vendor's profits as discussed in Claim 2 above.

Claim 9: Mattern discloses a computer system for generating user recommendations for a defined knowledge base, the computer system comprising a reasoning model, the reasoning model comprising:

- a. a processor, and
- b. a memory, including a component for storing, maintaining and representing a decision graph definable by an author (The user can modify the decision paths, column 5, lines 44-46), the decision graph comprising nodes and links between the nodes (a tree structure indicating their relationship, column 5, lines 33-54), the nodes comprising a set of decision nodes, and a set of feedback nodes, the decision nodes comprising question nodes and the feedback nodes comprising recommendation [and promotion] nodes, each of the nodes in the decision graph comprising rules defined by the author to define links to other nodes in the graph, and for a decision node, to request and obtain user information (question and reply nodes, column 6, lines 26-35), and for a feedback node, to provide feedback to users (solution nodes, column 6, lines 26-35), the rules defining links to other nodes in the decision graph comprising rules accessing and evaluating one of: personalization choices collected implicitly or explicitly from the user (the reply is evaluated, column 12, lines 4-16), static data relating to the user, a dynamically generated user model, attributes of elements in the knowledge base, and author-related goals; and utilizing one or more of: weighting systems, fuzzy logic systems, and probabilistic reasoning (neural networks, Column 13, lines 6-9), and a component to traverse the decision graph and fire the rules defined in the decision

graph nodes (the reply is evaluated and the knowledge module 208 is accessed to retrieve the next node corresponding to the selected reply, Column 12, lines 4-10); and a communication component for communicating the feedback to the users through the webserver to assist the users in making decisions regarding a business transaction (The Web server 202 acts as the presentation layer of the system 200, column 4, lines 56-67).

Mattern does not explicitly disclose the feedback nodes comprise promotion nodes. However, Herz discloses a similar system for the automatic determination of customized prices and promotions. The system automatically constructs product offers tailored to individual shoppers in a way that attempts to maximize the vendor's profits (Herz, paragraph [0004]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include promotional nodes in Mattern in order to provide customized prices and promotions which would attempt to maximize the vendor's profits (Herz, paragraph 0004).

The Examiner notes that the new limitation that the recommendation providing to the user by the feedback nodes are either an interim or final recommendation is inherent. If the recommendation provided in Mattern is subsequently replaced by another recommendation (i.e. updated), then it was an interim recommendation. If it is not replaced, then it was the final recommendation. Furthermore, Mattern explicitly discloses that the system will present to the user "a series of proposed solutions" (column 4, lines 46-50); thus, it is providing interim recommendations.

Claims 10/2, 10/3, and 10/9: Mattern and Herz disclose a computer program product for use in the computer system described in Claims 2, 3, and 9 above. Thus, claims 10/2, 10/3, and 10/9 are rejected using the same analysis of claims 2, 3, and 9 above.

Response to Arguments

13. Applicant's arguments filed November 19, 2007 have been fully considered but they are not persuasive.

The Applicant argues in reference to Claims 1, 9, 10 and 15, the Mattern does not disclose the feedback nodes are configured to provide either an interim or final recommendation to the user" (page 10). This has been addressed in the rejections of these claims above. Inherently, every recommendation is either an interim recommendation or a final recommendation, depending on whether or not a subsequent recommendation (update) is received. Furthermore, Mattern explicitly discloses that the system will present to the user "a series of proposed solutions" (column 4, lines 46-50); thus, it is providing interim recommendations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
March 6, 2008

/James W Myhre/
Primary Examiner, Art Unit 3688